

APPLICANT(S): MERON, Gavriel et al.
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

The Telephone Interview

Initially, Applicants wish to thank Examiner Robert L. Nasser for granting and attending the telephonic interview on June 8, 2004 with Applicants' representative, Caleb Pollack, Reg. No. 37,912, attorney of record for Applicants, and Rachel Bentov, a representative of the assignee. Also present in an observatory capacity were Dina Cohen and Joseph Sherinsky, interns at Eitan, Pearl, Latzer & Cohen Zedek LLP.

Applicants' representatives discussed with the Examiner proposed draft claim amendments. Applicants' representatives also discussed with the Examiner prior art cited by the Examiner in the subject office action, particularly Marshall, et al. U.S. Pat. No. 6,632,175, Doi JP 5015515 and Nakazawa JP 6142081. Applicants' representatives and the Examiner agreed on claim amendments that overcame the prior art rejections of record. The amendments submitted in this Amendment and Response include, inter alia, the agreed upon claim amendments.

STATUS OF CLAIMS

Claims 1-7, 10-15, 17-19, 21, 23-28, 31-37, 39-40, 47-48, 50-51, 53-58, 60, 63-65 and 67-68 are pending. The pending claims were rejected in the Final Office Action dated April 8, 2004. Claims 1, 19, 23, 25, 47, 56 and 63 have been amended.

Claims 8, 16, 22 and 29 were cancelled in a Preliminary Amendment dated March 28, 2003.

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Claims 9, 20, 30, 49, 52, 59, 61-62, 66 and 69 were cancelled in a Response to Office Action dated January 14, 2003.

Claims 41-46 were withdrawn by an election in response to a restriction requirement.

Claim 38 is cancelled herein without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in this claim to file divisional and/or continuation patent applications.

The amendments to the independent claims including a structure to immobilize the housing in-vivo have been made for the purposes of clarity.

Applicants respectfully assert that the amendments to the claims and specification add no new matter.

CLAIM REJECTIONS

35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claims 7 and 28 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. In response, Applicants respectfully assert that the Application as filed included the disclosure of a sensor of electrical conductivity, in claims 7 and 28. The specification has been amended to include this limitation. Applicant respectfully asserts that because the application as filed included this disclosure, the amendment to the specification does not constitute new matter. Applicant respectfully asserts that claims 7 and 28 are proper under 35 U.S.C. § 112 and requests that the rejection of claims 7 and 28 under 35 U.S.C. § 112 be withdrawn.

In the Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response, Applicants have amended claim 25 to correct a typographical error. Applicants respectfully assert that these amendments render claim 25 proper under 35 U.S.C. § 112 and requests that the rejection of claim 25 under 35 U.S.C. § 112 be withdrawn.

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The amendments to claim 25 are not made for reasons of patentability and do not narrow the scope of the claims. These amended claims are not subject to the complete bar against the use of the Doctrine of Equivalents as outlined in Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.

In the Office Action, the Examiner rejected claims 38 and 40 under 35 U.S.C. § 112 as being duplicates of each other. Claim 38 is cancelled hereinabove. Applicants respectfully assert that this cancellation renders claim 40 proper under 35 U.S.C. § 112 and requests that the rejection of claims 38 and 40 under 35 U.S.C. § 112 be withdrawn.

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 23, 26-27, 32-34, 38-40, 47-48, 50-51, 55-58, 60 and 67-68 under 35 U.S.C. § 102(b), as being anticipated by Swain, et al. WO 98/11816 ("Swain"). Applicants respectfully traverse the rejections of claims 23, 26-27, 32-34, 38-40, 47-48, 50-51, 55-58, 60 and 67-68 under 35 U.S.C. § 102(b), as being anticipated by Swain in view of the remarks that follow.

During the June 8 interview, the Examiner and Applicants' representatives agreed on amendments that would overcome the prior art rejections of record. These amendments are reflected in the amendments to the claims, above.

Applicants' independent claims 1 and 47 as amended include, inter alia, the limitation of an "optical dome". Applicants' independent claims 23 and 56 as amended include, inter alia, the limitation of an "optical sphere". Swain does not disclose a system with an optical sphere or dome or the use of an optical sphere or dome, as is variously recited in Applicants' independent claims 1, 23, 47 and 56. In order for a reference to anticipate a claim under 35 U.S.C. § 102(b), the reference must teach each and every element of the claim being rejected. Applicants assert that Swain does not teach every element of Applicants' independent claims 1, 23, 47 and 56, as amended. Applicants therefore assert that independent claims 1, 23, 47 and 56, as amended, are not anticipated by Swain. Applicants respectfully request that Examiner withdraw the rejection of independent claims 1, 23, 47 and 56, as amended, as being anticipated by Swain.

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As discussed, Applicants' independent claims 1, 23, 47 and 56 are allowable. Each of dependent claims 26-27, 32-34, 39-40, 48, 50-51, 55, 57-58, 60 and 67-68 depend, directly or indirectly, from one of independent claims 1, 23, 47 and 56, as amended, and thereby include all of the elements of one of these claims. Therefore, Applicants respectfully assert that dependent claims 26-27, 32-34, 39-40, 48, 50-51, 55, 57-58, 60 and 67-68 are likewise allowable and request the Examiner withdraw his rejection of dependent claims 26-27, 32-34, 39-40, 48, 50-51, 55, 57-58, 60 and 67-68 as being anticipated by Swain. Claim 38 is cancelled hereinabove. The rejection of claim 38 is therefore moot.

In the Office Action, the Examiner rejected claims 1, 2, 4, 11-12, 17-19, 21, 23-24, 32-33, 38-40, 47-48, 50-51, 53-58, 60 and 63-65 under 35 U.S.C. § 102(b), as being anticipated by Doi JP 5015515 ("Doi"). Applicants respectfully traverse the rejections of claims 1, 2, 4, 11-12, 17-19, 21, 23-24, 32-33, 38-40, 47-48, 50-51, 53-58, 60 and 63-65 under 35 U.S.C. § 102(b), as being anticipated by Doi in view of the remarks that follow.

During the June 8 interview, the Examiner and Applicants' representatives agreed on amendments that would overcome the prior art rejections of record. These amendments are reflected in the amendments to the claims, above.

Applicants' independent claims 1, 47 and 63 as amended include, inter alia, the limitation of an "optical dome". Applicants' independent claims 19, 23 and 56 as amended include, inter alia, the limitation of an "optical sphere". Doi does not disclose a system with an optical sphere or dome or the use of an optical sphere or dome, as is variously recited in Applicants' independent claims 1, 19, 23, 47, 56 and 63. In order for a reference to anticipate a claim under 35 U.S.C. § 102(b), the reference must teach each and every element of the claim being rejected. Applicants assert that Doi does not teach every element of Applicants' independent claims 1, 19, 23, 47, 56 and 63, as amended. Applicants therefore assert that independent claims 1, 19, 23, 47, 56 and 63, as amended, are not anticipated by Doi. Applicants respectfully request that Examiner withdraw the rejection of independent claims 1, 19, 23, 47, 56 and 63, as amended, as being anticipated by Doi.

As discussed, Applicants' independent claims 1, 19, 23, 47, 56 and 63 are allowable. Each of dependent claims 2, 4, 11-12, 17-18, 21, 24, 32, 33, 39-40, 48, 50-51, 53-55, 57-58, 60 and 64-65 depend, directly or indirectly, from one of independent claims 1, 19, 23, 47, 56

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and 63, as amended, and thereby include all of the elements of one of these claims. Therefore, Applicants respectfully assert that dependent claims 2, 4, 11-12, 17-18, 21, 24, 32, 33, 39-40, 48, 50-51, 53-55, 57-58, 60 and 64-65 are likewise allowable and request the Examiner withdraw his rejection of dependent claims 2, 4, 11-12, 17-18, 21, 24, 32, 33, 39-40, 48, 50-51, 53-55, 57-58, 60 and 64-65 as being anticipated by Doi. Claim 38 is cancelled hereinabove. The rejection of claim 38 is therefore moot.

In the Office Action, the Examiner rejected claims 23-24, 26-27, 32-35, 38-40, 47-48, 50-51, 53-54 and 63-65 under 35 U.S.C. § 102(e), as being anticipated by U.S. Pat. No. 6,285,897 to Kilcoyne, et al. ("Kilcoyne"). Applicants respectfully traverse the rejections of claims 23-24, 26-27, 32-35, 38-40, 47-48, 50-51, 53-54 and 63-65 under 35 U.S.C. § 102(e), as being anticipated by Kilcoyne in view of the remarks that follow.

During the June 8 interview, the Examiner and Applicants' representatives agreed on amendments that would overcome the prior art rejections of record. These amendments are reflected in the amendments to the claims, above.

Applicants' independent claims 47 and 63 as amended include, inter alia, the limitation of an "optical dome". Applicants' independent claims 23 and 56 as amended include, inter alia, the limitation of an "optical sphere". Kilcoyne does not disclose a system with an optical sphere or dome or the use of an optical sphere or dome, as is variously recited in Applicants' independent claims 23, 47, 56 and 63. In order for a reference to anticipate a claim under 35 U.S.C. § 102(e), the reference must teach each and every element of the claim being rejected. Applicants assert that Kilcoyne does not teach every element of Applicants' independent claims 23, 47, 56 and 63, as amended. Applicant therefore asserts that independent claims 23, 47, 56 and 63, as amended, are not anticipated by Kilcoyne. Applicants respectfully request that Examiner withdraw the rejection of independent claims 23, 47, 56 and 63, as amended, as being anticipated by Kilcoyne.

As discussed, Applicants' independent claims 23, 47, 56 and 63 are allowable. Each of dependent claims 24, 26-27, 32-35, 39-40, 48, 50-51, 53-54 and 64-65 depend, directly or indirectly, from one of independent claims 23, 47, 56 and 63, as amended, and thereby include all of the elements of one of these claims. Therefore, Applicants respectfully assert that dependent claims 24, 26-27, 32-35, 39-40, 48, 50-51, 53-54 and 64-65 are likewise

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allowable and request the Examiner withdraw his rejection of dependent claims 24, 26-27, 32-35, 39-40, 48, 50-51, 53-54 and 64-65 as being anticipated by Kilcoyne. Claim 38 is cancelled hereinabove. The rejection of claim 38 is therefore moot.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50, 51, 53-58, 60 and 63-65 under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,632,175 to Marshall, et al. ("Marshall") in view of Swain.

Applicants respectfully traverse the rejection of claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50, 51, 53-58, 60 and 63-65 under 35 U.S.C. § 103(a) as being obvious over Marshall in view of Swain.

During the June 8 interview, the Examiner and Applicants' representatives agreed on amendments that would overcome the prior art rejections of record. These amendments are reflected in the amendments to the claims, above.

Each of independent claims 1, 19, 23, 47, 56 and 63 includes, inter alia, one of the limitations of an "optical sphere" or an "optical dome". Applicants assert that neither Marshall nor Swain, alone or in combination, teach or suggest, an "optical sphere" or "optical dome", as is required by Applicants claims 1, 19, 23, 47, 56 and 63, as amended.

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Since, neither Marshall nor Swain, alone or in combination teach or suggest all the elements of any of claims 1, 19, 23, 47, 56 and 63, as amended, neither Marshall nor Swain, alone or in combination, render any of 1, 19, 23, 47, 56 and 63 obvious.

As discussed, claims 1, 19, 23, 47, 56 and 63, as amended are allowable. Since each of dependent claims 2, 4-7, 11-15, 17-18, 24, 26-28, 32-37, 39-40, 48, 50-51, 53-55, 57-58, 60, 62 and 64-65 depend directly or indirectly from one of independent claims 1, 19, 23, 47, 56 and 63, as amended, and include all of the elements of one of independent claims 1, 19, 23, 47, 56 and 63, Applicants assert that dependent claims 2, 4-7, 11-15, 17-18, 24, 26-28, 32-37, 39-40, 48, 50-51, 53-55, 57-58, 60, 62 and 64-65 are allowable

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Thus Applicants respectfully request that the rejection of claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50, 51, 53-58, 60 and 63-65 under 35 U.S.C. § 103(a) as being obvious over Marshall in view of Swain be withdrawn.

In the Office Action, the Examiner rejected claims 3 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Marshall in view of Swain, as applied to claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50-51, 53-58, 60 and 63-65, further in view of Sohrab. Applicants respectfully traverse the rejection of claims 3 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Marshall in view of Swain, as applied to claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50-51, 53-58, 60 and 63-65, further in view of Sohrab.

As discussed above, claims 1 and 23, as amended are allowable. Since each of dependent claims 3 and 25 depend from one of independent claims 1 and 23, as, amended, and include all of the elements of one of independent claims 1 and 23, Applicants assert that dependent claims 3 and 25 are allowable.

In the Office Action, the Examiner rejected claims 5, 6, 67 and 68 under 35 U.S.C. § 103(a) as being unpatentable over Doi in view of Iddan et al. Applicants respectfully traverse the rejection of claims 5, 6, 67 and 68 under 35 U.S.C. § 103(a) as being unpatentable over Doi in view of Iddan et al.

As discussed above, claims 1 and 23, as amended are allowable. Since each of dependent claims 5, 6, 67 and 68 depend directly or indirectly from one of independent claims 1 and 23, as, amended, and include all of the elements of one of independent claims 1 and 23, Applicants assert that dependent claims 5, 6, 67 and 68 likewise are allowable.

In the Office Action, the Examiner rejected claims 10 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Marshall in view of Swain as applied to claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50-51, 53-58, 60 and 63-65, further in view of Fiddian-Green. Applicants respectfully traverse the rejection of claims 10 and 31 under 35 U.S.C. § 103(a) as applied to claims 1, 2, 4-7, 11-15, 17-19, 23-24, 26-28, 32-40, 47-48, 50-51, 53-58, 60 and 63-65, further in view of Fiddian-Green.

As discussed above, claims 1 and 23, as amended are allowable. Since dependent claims 10 and 31 depend directly or indirectly from one of independent claims 1 and 23, as

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amended, and include all of the elements of one of independent claims 1 and 23, Applicants assert that dependent claims 10 and 31 are allowable.

In the Office Action, the Examiner rejected claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Swain. Applicants respectfully traverse the rejection of claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Swain.

As discussed above, claim 23, as amended is allowable. Since dependent claims 36 and 37 depend directly or indirectly from independent claim 23, as amended, and include all of the elements of independent claim 23, Applicants assert that dependent claims 36 and 37 are allowable.

In the Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Kilcoyne in view of Sohrab. Applicants respectfully traverse the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Kilcoyne in view of Sohrab.

As discussed above, claim 23, as amended is allowable. Since dependent claim 25 depends directly or indirectly from independent claim 23, as amended, and includes all of the elements independent claim 23, Applicants assert that dependent claim 25 is allowable.

In the Office Action, the Examiner rejected claims 67 and 68 under U.S.C. § 103(a) as being unpatentable over Kilcoyne in view of Swain. Applicants respectfully traverse the rejection of claims 67 and 68 under U.S.C. § 103(a) as being unpatentable over Kilcoyne in view of Swain.

As discussed above, claims 1 and 23, as amended are allowable. Since dependent claims 67 and 68 depend directly or indirectly from one of independent claims 1 and 23, as amended, and include all of the elements of one of independent claims 1 and 23, Applicants assert that dependent claims 67 and 68 are allowable.

In the Office Action, the Examiner rejected claim 31 under U.S.C. § 103(a) as being unpatentable over Fiddian-Green. Applicants respectfully traverse the rejection of claim 31 under U.S.C. § 103(a) as being unpatentable over Fiddian-Green.

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As discussed above, claim 23, as amended is allowable. Since dependent claim 31 depends from independent claim 23, as amended, and includes all of the elements of independent claim 23, Applicants assert that dependent claim 31 is allowable.

In the Office Action, the Examiner reject claims 36 and 37 under U.S.C. § 103(a) as being unpatentable over Kilcoyne. Applicants respectfully traverse the rejection of claims 36 and 37 under U.S.C. § 103(a) as being unpatentable over Kilcoyne.

As discussed above, claim 23, as amended is allowable. Since dependent claims 36 and 37 depend directly or indirectly from independent claim 23, as amended, and include all the elements of independent claim 23, Applicants assert that dependent claims 36 and 37 are allowable.

In the Office Action, the Examiner rejected claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Swain. Applicants respectfully traverse the rejection of claims 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Swain.

As discussed above, claim 23, as amended is allowable. Since dependent claims 36 and 37 depend directly or indirectly from independent claim 23, as amended, and include all of the elements of independent claim 23, Applicants assert that dependent claims 36 and 37 are allowable.

In the Office Action, the Examiner rejected claims 67 and 68 under U.S.C. § 103(a) as being unpatentable over Marshall in view of Iddan. Applicants respectfully traverse the rejection of claims 67 and 68 under U.S.C. § 103(a) as being unpatentable over Marshall in view of Iddan.

As discussed above, claims 1 and 23, as amended are allowable. Since dependent claims 67 and 68 from one of independent claims 1 and 23, as amended, and include all of the elements of one of independent claims 1 and 23, Applicants assert that dependent claims 67 and 68 are allowable.

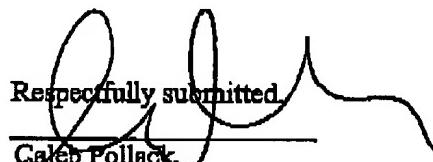
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Conclusion

Applicants submit that, for at least the reasons presented above, the Applicants' claims are patentable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

No fee is believed to be due, however, if any fee is due, please charge any such fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,

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